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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
DARIUS J. PREISLER

Serial No.: 09/620,581

Group Art Unit: 2167

Filed: July 20, 2000

Examiner: C. Buchanan

For: OCCUPANT PROTECTION SYSTEM
FOR VEHICLE WITH AIR BAG

Attorney Docket No.: VEI 0319 PUS

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REVISED APPEAL BRIEF

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Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450 -
Alexandria, VA 22313-1450

Sir:

This is an appeal brief from the final rejection of claims 1 and 4-6 of the Office Action dated March 27, 2002. This application was filed on July 20, 2000.

REMARKS

This is a revision of the Appeal Brief filed September 17, 2002. This Revised Appeal Brief is filed in response to a Notification of Non-Compliance with the Requirements of 37 C.F.R. 1.192(c)(5) dated April 20, 2004, as best understood.

The Appendix enclosed with the Appeal Brief initially filed September 17, 2002, and subsequently sent via facsimile on September 30, 2003 included the claims on appeal. The

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Box AF, Commissioner for Patents, United States Patent and Trademark Office, Washington, D.C. 20231 on:

April 29, 2004
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Thomas W. Saur
Name of Person Signing


Signature

Appendix filed herewith provides a re-submission of the claims on appeal.

The Grouping of Claims section of the Appeal Brief has been revised to include a detailed statement explaining why the claims of the groups are believed to be separately patentable.

Further, though not indicated as a deficiency in the Notification of Non-Compliance, the Summary of the Invention section of the Appeal Brief has been revised to include reference characters, and reference to the specification by page and line number, and to the drawings to provide a concise explanation of the invention. As such, the Appeal Brief is believed to be fully compliant with 37 C.F.R. 1.192(c)(5).

I. REAL PARTY IN INTEREST

The real party in interest is Patent Holding Company, a corporation organized and existing under the laws of the state of Michigan, and having a place of business at 3662 James J. Pompo, Fraser, Michigan 48026, as set forth in the assignment recorded in the U.S. Patent and Trademark Office on July 20, 2000 at Reel 010955/Frame 0353.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present appeal.

III. STATUS OF CLAIMS

This application was filed on July 20, 2000. The application included claims 1-4 as filed. Claims 2 and 3 were canceled and claims 5 and 6 were added by an Amendment filed November 21, 2001. Claims 1 and 4-6 were finally rejected and are the subject of this appeal. The claims that are the subject matter of this appeal are reproduced in Appendix A.

IV. STATUS OF AMENDMENTS

The Amendment filed on April 18, 2002 was not entered.

V. SUMMARY OF THE INVENTION

The invention provides an occupant protection system for deploying a deployable air bag from a concealed location in a vehicle instrument panel (14) having an opening (20). The protection system includes an air bag (16) normally containable in a deflated condition adjacent the opening and deployable through the opening as a protection for the occupant. The air bag has a skin (18) and a portion (34) of that skin closes the opening when the air bag is deflated and remains as a portion of the air bag after the air bag is deployed.

The invention also provides in combination, a vehicle having an air bag deployable upon vehicle impact and an occupant protection system for deploying a deployable air bag from a concealed location in a vehicle instrument panel (14) having an opening (20). The protection system includes an air bag (16) normally containable in a deflated condition adjacent the opening and deployable upon vehicle impact through the opening as a protection for the occupant. The air bag has a skin (18) and a portion (34) of that skin closes the opening when the air bag is deflated and remains as a portion of the air bag after the air bag is deployed.

The invention further provides the system and combination described above wherein the skin that closes the opening is flush with the vehicle instrument panel. (See, for example, Figs. 1-6, and the specification on page 5, ll. 11-26).

VI. ISSUES

1. Claims 1 and 4-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Madrigal et al. in view of Ward et al. The issue is whether the Examiner properly rejected the claims under Madrigal et al. in view of Ward et al.

VII. GROUPING OF CLAIMS

Applicant contends that the claims do not stand or fall together. In particular, Applicant contends the claims may be grouped as follows:

1. Claims 1 and 4 (Group 1) stand or fall together.
2. Claims 5 and 6 (Group 2) stand or fall together.

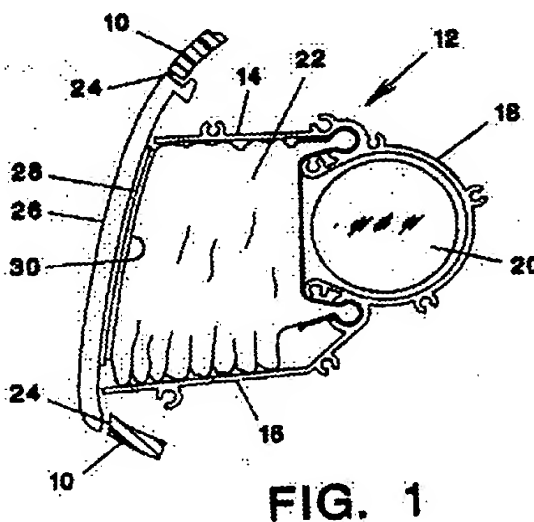
As is argued in detail below, Groups 1 and 2 are independently patentable. In particular, the claims in each of the Groups provide limitations that are separately patentable over the cited art from the other Group. Claims 1 and 4 are the independent claims involved in the appeal. Dependent claims 5 and 6 are separately distinct and provide limitations (e.g., skin that closes an opening is flush with a vehicle instrument panel) that are separately patentable from their respective independent claims and are, therefore, additionally argued separately, and stand separately.

VIII. ARGUMENT

1. **The Examiner improperly rejected claims 1 and 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Madrigal et al. in view of Ward et al.**

The Examiner rejected claims 1 through 4 under 35 U.S.C. § 103(a) as being unpatentable over Madrigal et al. (USPN 5,521,377) in view of Ward et al. (5,480,183).

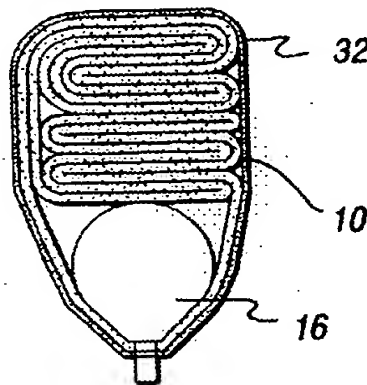
Independent claims 1 and 4 include the limitation that “the air bag ha[s] a skin and a portion of that skin closes the opening” Neither Madrigal nor Ward disclose an air bag having a skin and a portion of that skin that closes the opening. Ward discloses and requires a door 26 for closing the opening. *See*, Ward, Figure 1 below.



In fact, claim 1, the only independent claim in Ward, requires “a door . . . forming a portion of the interior trim of said vehicle but openable under the influence of the

expanding airbag ... and means for ... restraining motion of said door during such inflation ... wherein said securing and restraining means comprises: a pressure-sensitive material interconnecting said airbag and door whereby the folded air bag maintains said door in its closed position” Ward further claims that the pressure-sensitive material are “sheet-like” members (claim 2) and “hook and loop tear-apart fasteners” (claim 3). As evidenced by its inclusion into the independent claim, the door is a critical feature of Ward.

Madrigal discloses a perforated paper cover 32 which encloses the folded air bag 10 and inflator 16. *See*, Madrigal, column 3, lines 48-49 and Figure 17 reproduced below. Madrigal does not disclose any relationship between the air bag and an instrument panel.



Both prior art patents disclose covers or doors that cover the air bag. The combination of Madrigal and Ward therefore cannot be the basis for a 103(a) rejection because a claimed, material limitation, *i.e.*, that the air bag has a skin and a portion of that skin closes the opening, is absent from the prior art. *In re Fine*, 837 F.2d 1071, 1075-76, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). The prior art simply does not teach, suggest, or disclose each

and every element as set forth in the claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Further, the cover of Madrigal could not be removed without improperly destroying the intended function of the invention disclosed therein and therefore, the combination of art is improper. *In re Golden*, 733 F.2d 900, 221USPQ 1125 (Fed. Cir. 1984). In Madrigal, "the paper cover 32 ... encloses the folded airbag 10." Madrigal, col. 3, lines 48-49. Without the cover, the air bag would not stay folded and function as claimed.

Additionally, the door of Ward could not be removed without improperly destroying the intended function of the invention disclosed therein and therefore, the combination of art is improper. *In re Golden*, 733 F.2d 900, 221USPQ 1125 (Fed. Cir. 1984). Ward specifically claims a door connected to the air bag in its claims. Without the door, the invention would not function as intended because a material element of the invention would be missing. Ward requires the door to close the opening in the instrument panel.

In the Claim Rejections section of the Final Office Action mailed March 27, 2002, the Examiner stated that it would be obvious "to modify the occupant protection system of Madrigal to include an airbag stored near and deployed through an opening in the instrument panel and a cover that is flush with the panel, as taught by Ward, to provide an airbag system with a cover that does not need to be attached to the airbag module." (emphasis added.) In the Response to Arguments section of the Final Office Action, the Examiner stated "it would be obvious to one skilled in the art that the location of the cover relative to the instrument panel could be varied as required by design." (emphasis added.) The Examiner fails to properly grasp the invention. There is no cover on the present invention as there is in Madrigal (paper cover 32) or Ward (cover 26). Rather, it is the air bag itself that closes the opening.

Further, there is no suggestion to modify either Madrigal or Ward by removing the covers and doors required by both inventions. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive that supports the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). As described above, the covers and doors are critical features in both Madrigal and Ward and both inventions would not be able to function as intended without the doors and covers present. There is no incentive to modify the prior art by removing critical features from the prior art. The Examiner has not provided the required particular findings supporting the Examiner's suggestion to modify the prior art by eliminating the cover and door. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Without any particular findings supporting the Examiner's modifications of the prior art to eliminate the covers or doors, there can be no *prima facie* case of obviousness.

Accordingly, claims 1 and 4 are patentably distinguishable over Madrigal in view of Ward.


Claims 5 and 6, dependent on claims 1 and 4 respectively, further define Applicant's invention over the prior art. For instance, the prior art does not disclose or suggest that the skin that closes the opening is flush with the vehicle instrument panel. Madrigal does not disclose the relationship of the air bag relative to an instrument panel or an opening in the instrument panel. Ward clearly shows that the cover 26 is flush with the instrument panel and that the air bag skin is depressed relative to the instrument panel. *See*, Ward, Figure 1 reproduced above. Therefore, the combination of Madrigal and Ward cannot be the basis for a 103(a) rejection of claims 5 and 6 because a claimed, material limitation, *i.e.*, that the skin that closes the opening is flush with the vehicle instrument panel, is absent from the prior art. *In re Fine*, 837 F.2d 1071, 1075-76, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

IX. CONCLUSION

Claims 1 and 4-6 are patentable over Madrigal in view of Ward because the prior art does not teach, suggest, or disclose each and every element as set forth in the Applicant's claims and the combination of prior art is improper because there is no suggestion to modify the claims as suggested by the Examiner and modifying the prior art as suggested by the Examiner would destroy the intended function of the prior art.

The fee of \$320.00 as applicable under the provisions of 37 C.F.R. § 1.17(c) was enclosed with the initial and timely filing of the Appeal Brief on September 17, 2002. Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 02-3978. A duplicate of this notice is enclosed for this purpose.

Respectfully submitted,
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Date: April 29, 2004

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Enclosure - Appendix, Claims on Appeal

IX. APPENDIX - CLAIMS ON APPEAL

1. An occupant protection system for deploying a deployable air bag from a concealed location in a vehicle instrument panel having an opening, the protection system comprising:

an air bag normally containable in a deflated condition adjacent the opening and deployable through the opening as a protection for the occupant; and

the air bag having a skin and a portion of that skin closes the opening when the air bag is deflated, and remaining as a portion of the air bag after the air bag is deployed.

4. In combination, a vehicle having an air bag deployable upon vehicle impact and an occupant protection system for deploying a deployable air bag from a concealed location in a vehicle instrument panel having an opening, the protection system comprising:

an air bag normally containable in a deflated condition adjacent the opening and deployable upon vehicle impact through the opening as a protection for the occupant; and

the air bag having a skin and a portion of that skin closes the opening when the air bag is deflated and remaining as a portion of the air bag after the air bag is deployed.

5. The occupant protection system of claim 1 wherein the skin that closes the opening is flush with the vehicle instrument panel.

6. The combination of claim 4 wherein the skin that closes the opening is flush with the vehicle instrument panel.